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| 10/537,865 | 06/07/2005 | George Moore | PIPE0111PUSA | 8376 |
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| BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075 | | | EXAMINER TALBOT, MICHAEL | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,865

Applicant(s)

MOORE, GEORGE

Examiner

Michael W. Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/17/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-25, drawn to a drilling jig apparatus to be used with a drill press.

Group II, claim(s) 26 and 27, drawn to method of using a drill jig with a drill press.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Inventions I and II – the common features are a work piece holder, a clamping member, a work piece stopper and a pivot pin. These features are not considered “special” with respect to the Drilling Jig art, and therefore the inventions do not share the same or corresponding “special technical feature”.

3. There is an examination and/or search burden for these patentably distinct inventions due to their mutually exclusive characteristics. The inventions require a different field of search (e.g. searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one invention would not likely be applicable to another invention; and/or the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

4. During a telephone conversation with Mr. John E. Nemazi on Friday, 12 October 2007 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1-

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25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 26 and 27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: (1) "66", "71", "73", "74A" and "74B" shown in Fig. 5, and (2) "70" shown in Fig. 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly

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labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: (1) "longitudinal slot 28" first described on page 9, lines 4-8 and again on page 10, lines 5-11, (2) "angular direction A" described on page 10, lines 5-11, (3) "side edge 29(b)" described on page 10, lines 13-17, and (4) "channel 62" first described on page 11, lines 24-31. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

8. The drawings are objected to under 37 CFR 1.83(a) because they fail to show (1) "the horizontal planar member 2 having two longitudinal slots 22,28 extending there through" as

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described in the specification on page 9, lines 4-8, (2) "an elongate member 65" described on page 11, lines 24-31 and shown in Fig. 5 as a knob, and (3) "channel 62" described on page 11, lines 24-31 and again on page 12, lines 1-8 is shown in Fig. 5 as a slot. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

9. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "work piece holder can be rotated to 360° with respect to a horizontal plane of the first horizontal member" recited in claim 24 must be shown and/or indexed or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

10. The disclosure is objected to because of the following informalities:

Refer to page 5, line 5, the second occurrence of the word "be" within the phrase "the stop can be releasably be held in position by" so as to read --the stop can be releasably held in position by--.

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Refer to page 5, line 10, the word "to" should be inserted within the phrase "to allow the stop move up and down " so as to read --to allow the stop to move up and down--.

Refer to page 9, line 6, the character reference "Longitudinal slot 20" should be changed so as to read --Longitudinal slot 22--.

Refer to page 9, line 25, the character reference "two side edges 291(a),58" should be changed so as to read --two side edges 29(a),58--.

Refer to page 10, line 1 the "s" should be deleted from the word "members" so as to read --member--.

Refer to page 11, line 28, the character reference "elongate member 65" should be changed so as to read --work piece holder 3--.

Refer to page 11, line 29, the character reference "elongate member 65" should be changed so as to read --work piece holder 3--.

Refer to page 12, line 5, the character reference "elongate member 65" should be changed so as to read --work piece holder 3--.

Appropriate correction is required.

Claim Objections

11. Claims 6-8,15,16,19 and 24 are objected to because of the following informalities:

Claim 6, line 1 the "s" should be deleted from the element "first horizontal planar members" so as to read --first horizontal planar member--.

Claim 7 recites the limitation "the position" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 8, line 5, the word "atop" should be changed so as to read --top--.

Claim 15, line 2, the word "holder" should be insert between the word "work piece" and "such" so as to read --work piece holder such --.

Claim 16 recites the limitation "the fixing means" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "the elongate member" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "the inside walls" in lines 3 through 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "the mouth" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "the channel" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 24 recites the limitation "the horizontal plane" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is

followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 1 recites the broad recitation "in a work piece", and the claim also recites "typically a piece of wood" which is the narrower statement of the range/limitation.

In the present instance, claim 9 recites the broad recitation "a linear measurement", and the claim also recites "typically that of a ruler" which is the narrower statement of the range/limitation.

In the present instance, claim 10 recites the broad recitation "a fastening means", and the claim also recites "typically a spanner" which is the narrower statement of the range/limitation.

In the present instance, claim 11 recites the broad recitation "an aperture", and the claim also recites "preferably a longitudinal extending slot" which is the narrower statement of the range/limitation.

In the present instance, claim 24 recites the broad recitation "can be rotated to 360°", and the claim also recites "typically between 0° and 180°" which is the narrower statement of the range/limitation.

15. Regarding claim 14, it is unclear from the disclosed specification and the drawings as to the "fixing means connectable to the stopper means to allow the position of the stopper means to be adjusted". It appears that the fixing means would be the stop holder 37, washer 66 and

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knob 65 as viewed in Fig. 5, however the disclose specification does not provide clear support for this.

16. Regarding claim 15, it is unclear from the disclosed specification and the drawings as to the "holes spaced apart along the longitudinal length of the work piece such that the fixing means can be inserted in a respective hole to hold the stopper means at a desired position on the length of the work piece holder". As viewed in Fig. 5, the only "hole" that the stopper is shown to be inserted into is identified by item 64, which the specification describes as a channel. There is no other "hole" shown. It appears that the "fixing means" may be the stop holder 37, but support from the disclosed specification is not clear.

17. Regarding claim 24, it is unclear from the disclosed specification and the drawings as to how the "work piece holder can be rotated to 360° with respect to a horizontal plane of the first horizontal member", since the Figures show a finite arcuate slot within protractor 27 that the first horizontal member (20) can be moved within. The arcuate slot 27A does not allow for 360° movement.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. Claims 1,2,6,7,10-13 and 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Woods et al. '901. Woods et al. '901 shows in Figures 1-7 a drilling jig (9) adapted to be used with a drill press (11,12,35) to guide a drill (12) for drilling aligned holes in a wooden work piece (19A-19E) wherein the jig includes an attachment means (13,15,16) adapted to be releasably attached to a drill press table (11), a work piece holder (10) pivotally

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connect to the attachment means (Fig. 7 and col. 3, lines 28-38) and the work piece holder is adapted to releasably hold a work piece (via jaws 18,20) in position whereby the work piece pivots relative to the attachment means (Fig. 7 and col. 3, lines 28-38) to allow for angled drilling on the held work piece. Woods et al. '901 shows the attachment means includes a first horizontal member (long side of L-shaped member 13 placed flush against drill press table 11 as viewed in Fig. 7) having at least one longitudinal slot (15) for accommodating a first clamp (16) to releasably attach the first horizontal member at different positions on the drill press table. Woods et al. '901 shows the work piece holder being pivotally connected to a side edge (at 17) of the first horizontal planar member and depending downwardly (toward the right as shown in Fig. 7) from the first horizontal planar member. Woods et al. '901 shows the work piece holder being pivotally connected to the first horizontal planar member by an adjustable pivot pin (30) that allows for pivot free movement when the pivot pin is untightened and allows the work piece holder to be held in a position at a desired angle when the pivot pin is tightened (Fig. 7). Woods et al. '901 shows wherein the adjustable pivot pin is tightened by a fastening means. Woods et al. '901 shows the first horizontal planar member having an elongated aperture slot (31) adapted to allow the adjustable pivot pin to be tightened by the fastening means. Woods et al. '901 shows the work piece holder including a clamp (18,20) to hold the work piece in position and also includes an adjustable stopper means (27A,27B) adapted to allow a bottom portion of the work piece to rest on the stopper means. Woods et al. '901 shows the work piece clamp holding the work piece against a surface (at 17) of the horizontal planar member. Woods et al. '901 shows the attachment means (13,15,16) including an angular adjustment means (30,32,34) whereby an angle of the work piece holder (10) relative to the attachment means can be adjusted (Fig. 7), wherein the angular adjustment means is a protractor (34) having an arcuate slot (31) through which a clamping means (30,32,34) can pass so that the work piece holder

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can be set at a desired angle (col. 4, line 63 through col. 5, line 8). Woods et al. '901 shows the protractor clamping means comprises a threaded bolt (30) and a wing nut or knurled knob (head of bolt as viewed in Fig. 3) integral with the threaded bolt for providing the clamping means.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woods et al. '901. Woods et al. '901 discloses the claimed invention except for the presence of "a second horizontal planar member having at least one longitudinal extending slot for accommodating a second clamp to releasably attach to the drill press, adjacent to the first horizontal planar member". However, Woods et al. '901 does disclose a first horizontal planar member (13,15,16) with at least one longitudinal extending slot (15) for accommodating a clamp (16) for attachment to a drill press table (11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to "include a second horizontal planar member having at least one longitudinal extending slot for accommodating a second clamp to releasably attach to the drill press, adjacent to the first horizontal planar member" for the purpose of improved alignment and securement of the drilling jig because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

22. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woods et al. '901 in view of Dion '940. Woods et al. '901 lacks specific indicia present on a first horizontal planar member and a second horizontal planar member.

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Dion '940 shows indicia (30,32,34) present on the first horizontal planar member (54) and a second horizontal planar member (56) comprising a linear ruler measurement (30,32) and a triangle shaped pointer (34). In view of this teaching of Dion '940, it would have been obvious to one of ordinary skill in the art to modify the drilling jig of Woods et al. '901 to include indicia as taught by Dion '940 to provide a visual means to accurately and repeatably set the position of the first and second horizontal planar members with respect to that of the work piece for purposes of recording.

Allowable Subject Matter

23. Patentability of claims 14-19 can not be determined at this time due to applicant failing to particularly point out and distinctly disclose and claim the subject matter which applicant regards as the invention. The lack of clarity of the submitted disclosure resulting in the numerous objections to the drawings and specification, along with the rejection to the claims under 35 U.S.C. 112, 2nd paragraph set forth in this Office action, requires the applicant to review the application in its entirety and make the necessary amendments to the claims, specification and drawings so as to clearly set forth what applicant regards as the invention.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

25. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300.

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This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account.

Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT

Examiner

12 October 2007



MONICA CARTER
SUPERVISORY PATENT EXAMINER